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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,172	01/29/2001	John L. Cartier	29026-P01	9721
26486	7590	09/09/2004	EXAMINER	
PERKINS, SMITH & COHEN LLP			CHANG, VICTOR S	
ONE BEACON STREET			ART UNIT	
30TH FLOOR			PAPER NUMBER	
BOSTON, MA 02108			1771	

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

S.C.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/772,172	CARTIER, JOHN L.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Victor S Chang	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Introduction*

1. The Examiner has carefully considered Applicant's Declaration, amendments and remarks filed on 7/2/2004. Applicant's amendments to claims 1-6 and 9 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, applicant's argument "support is also found in the U.S. Provisional application (Serial No. 60/179,107)" (Remarks, page 6) is persuasive. As such, the objection in section 4 of Office action dated 3/26/2004 is now withdrawn. However, in response to the substantial amendment to claim 1, the Examiner restates the rejection set forth in sections 4 of Office action dated 3/6/2003.
4. While the newly submitted Declaration by Mr. Cartier, which attest that J.L.C. Enterprise, Inc. has sold some \$900,000 worth of ice breaker mat (section 3 and appendix), appears to be persuasive that there is a market need for such a product, the Examiner respectfully notes that in addition to the relied upon prior art references of Onderak and Juneau, as set forth above, the extremely broad language in claim 1 fails to distinguish the instant invention as non-obvious and distinct, as shown by the following additional new grounds of rejections. Also, the Declaration appears to be non-commensurate with the scope of the claims, because it appears that the success of

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Applicant's device is due to a quite specific structure, not the generic article currently claimed. For commercial success to be persuasive, a nexus must be shown between the difference exhibited over the prior art and the success enjoyed.

### ***Drawings***

5. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the hand written drawing filed 1/29/2001 is clearly informal. For example, it is unclear what is the exact meaning of the two arrows in the TOP VIEW, the way the elements are numbered appears to be unconventional, and the Figure number is absent, etc. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings.

### ***Rejections Based on Prior Art***

6. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by Onderak et al. (US 4403009), substantially for the reasons set forth in sections 4 of Office action dated 3/6/2003, together with the following additional observations.

It is noted that claim 1 has been substantially amended to recite the following newly added elements: "flexible ... mat including a flexible core material of substantially uniform thickness sealed air tight within a water-proof, flexible cover ...".

In response to Applicant's amendment, the Examiner would like to first repeat the relied upon prior art reference as follows.

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Onderak's invention is directed to a skid resistance resilient floor covering. In Fig. 1, a section of the floor covering is illustrated. The covering can be made in a specific pattern from specifically defined sections of the material of the invention, i.e., the floor covering can then be made of the width, length and configuration of the area involved (column 1, lines 21-31). Fig. 4 shows a cross section of the covering having substantially uniform thickness. The wear layer 52 is formed, preferably, of a polyvinyl chloride resin (column 2, lines 10-11). The foam layer 54 has a thickness within the range of between about 0.05 and 0.2 inches (column 2, lines 19-20). The bottom film layer 58 seals floor covering (column 4, lines 28-39). Any liquid dropping onto the surface will be contained within the dams together with the corner sections, i.e., waterproof (column 3, lines 37-39). Finally, Onderak teaches that the border area of the covering is air impervious, so as to provide a border sealing area along the edge outline of the mat (column 3, lines 55-57).

For claim 1, Onderak teaches all the elements of the instant invention, except being silent about a functional property that the floor cover is non-adhering to ice. However, since Onderak teaches that the wear layer is preferably formed of PVC, as set forth above, which is the same polymer as the outer coating of the instant invention (specification, paragraph 0034), it is believed that the floor covering being non-adhering to ice is inherently disclosed. Finally, regarding the use recitation (method of eliminating ice), the Examiner notes that Applicant fails to appreciate that in an article claim statements of contemplated usage are patentably irrelevant.

With respect to Applicant's argument "Neither Onderak et al. nor Juneau teach or suggest a core and cover configuration. Each of the cited references teaches laminates comprised of multiple layers of various materials, not a one piece cover surrounding a flexible foam core." (Remarks, pages 6-7, bridging paragraph) has been carefully considered, but is not persuasive. The Examiner notes that Applicant's argument is not commensurate with the recitation in claim 1. It should be noted that while claim 1 recites "one-piece ... mat ...", it does not recite a "one piece cover surrounding a flexible foam core". Further, since Onderak expressly teaches that "the border area ... are air impervious to provide a border sealing area along the edge outline of the mat", as set forth above, clearly Onderak does teach a one piece floor cover, Applicant's argument to the contrary notwithstanding.

7. Claims 2-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onderak et al. (US 4403009) in view of Juneau (US 5100716), substantially for the reasons set forth in sections 5 of Office action dated 3/26/2004, together with the following additional observations.

With respect to Applicant's argument that "Onderak et al. are concerned about spills of liquids and have formed "dams" ... Their surface is structured so that the shoes of people are raised above the level of the liquid, rather than being frozen on the surface where a person's foot would contact and break any ice formed" (Remarks, page 7, top paragraph), the Examiner notes that Applicant's argument has been fully considered, but is not persuasive. In particular, Applicant argues the cited references individually. In response to Applicant's arguments, it is asserted that one cannot show

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non-obviousness by attacking references individually where the rejections are based on combinations of references. It should be noted that the combined teachings of Onderak and Juneau render the instant invention obvious, and Juneau's teaching of a low-profile ribbed outer surface (Abstract), as shown in Fig. 1, does not require a "dam" structure. Additionally, the Examiner notes that the fact that Onderak teaches additional structure not claimed is irrelevant, because Onderak's teaching of a skid resistance covering reads on the instantly claimed slip-resistant cover as claimed.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Fleming et al. (US 6321401).

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Fleming's invention is directed to a mat having individual segments containing foam padding and a contiguous cover of impervious material. The cover is constructed by radio frequency (RF) sealing. The mat also can be constructed with only one padded section (Abstract). Fig. 5 shows that the mat has substantially uniform thickness. The application relates generally to portable rest or sleeping surfaces, i.e., flexible (column 1, lines 9-10). Cover of mat preferably is constructed from a material which is fire retardant and durable, such as approximately 10 mil to approximately 20 mil super strong vinyl (PVC) (column 3, lines 5-8).

For claim 1, Fleming teaches all the elements of the instant invention, except being silent about a functional property that the floor cover is non-adhering to ice. However, since Fleming teaches that the cover is preferably constructed from PVC, as set forth above, which is the same polymer as the outer coating of the instant invention (specification, paragraph 0034), it is believed that the mat being non-adhering to ice is inherently disclosed. As to the use recitation (method of eliminating ice), the Examiner notes that Applicant fails to appreciate that in an article claim statements of contemplated usage are patentably irrelevant.

**10.** Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by Nelson (US 4985106).



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Nelson's invention is directed to panel includes a first layer of enclosing material which has greater tear resistance, a second layer of similar enclosing material is selected and configured so as to having a matching peripheral edge or contour with the first layer. Ultimately these two layers of enclosing material are joined together around their peripheral edges so as to define and completely enclose an interior cavity. Into this interior cavity a blanket of insulating material (foam) is dispersed of a generally uniform blanket thickness (Abstract). In the preferred embodiment, the cover sheets are constructed from polyethylene film, PVC film, etc. (column 7, lines 49-50).

For claim 1, Nelson teaches all the elements of the instant invention, except being silent about a functional property that the panel cover is non-adhering to ice. However, since Nelson teaches that the cover is preferably constructed from PVC, as set forth above, which is the same polymer as the outer coating of the instant invention (specification, paragraph 0034), it is believed that the panel cover being non-adhering to ice is inherently disclosed. As to the use recitation (method of eliminating ice), the Examiner notes that Applicant fails to appreciate that in an article claim statements of contemplated usage are patentably irrelevant.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interest for making cushion with impervious surfaces.

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DE 3512400A (Derwent Abstract) is directed to a molded cushion has a porous core of plastic or rubber foam with/without spaces and /or reinforcements inside it and with at least one surface having its pores covered over by an air and water-tight covering on all the faces.

**12.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*VSC*  
Victor S Chang  
Examiner  
Art Unit 1771

8/19/2004

  
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